

Atty. Dkt. No. 035451-0127 (3626.Palm)

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 18, 29, and 36 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier.

After amending the claims as set forth above, claims 18-37 are now pending in this application.

1. Rejection of Claims 24, 26, 33-35, and 37 Under 35 U.S.C. § 112 ¶ 1

On page 2 of the Office Action, claims 24, 26, 33-35, and 37 were rejected under 35 U.S.C. § 112 ¶ 1, as failing to comply with the written description requirement.

With respect to claims 24, 33, and 34, the Examiner stated that these claims

comprise the limitation of configuring the light sensors to a "back surface of the housing" (see claims 24, 33, and 34) which was not described in the specification in such a way as to convey to one skilled in the art [that the inventors,] at the time the application was filed, had possession of the claimed invention.

Applicants respectfully disagree. Paragraphs [0017] and [0018] disclose a variety of locations on the housing where light sensors may be disposed. Paragraph [0018], in particular, concludes that "sensors 121 and 123 may be provided in any location away from display 113." Applicants submit that these paragraphs demonstrate that Applicants had possession of providing light sensors on any surface of the housing, including a "back surface of the housing," and that claims 24, 33, and 34 are therefore in compliance with the written description requirement of 35 U.S.C. § 112 ¶ 1. Applicants respectfully request that the rejection of claims 24, 33, and 34 be withdrawn.

-5-

MLW_2606019

Application No. 09/842,561

Atty. Dkt. No. 035451-0127 (3626.Palm)

With respect to claims 26, 35, and 37, the Examiner stated that these claims

comprise the limitation of the adjusting a characteristic of the handheld computer/computing electronics, the characteristic being a brightness behind a plurality of input buttons (see claims 26, 35 and 37) which was not described in the specification in such a way as to convey to one skilled in the art [that the inventors,] at the time the application was filed, had possession of the claimed invention.

Applicants respectfully disagree, and point out that the present application recites that "[c]ontrol signal 412 is used to control the brightness of display 113, and control signal 414 is used to control the contrast of the display 113," paragraph [0023], and that "[a] plurality of input buttons 120 . . . may be provided on a portion of display 113," paragraph [0015]. Further, paragraph [0015] goes on to recite that "[d]isplay 113 may be a . . . backlit [display]." Applicants submit that this clearly supports the limitation of adjusting a "brightness behind [a] plurality of input buttons" as recited in each of claims 26, 35, and 37. Applicants respectfully request that the rejection of claims 26, 35, and 37 be withdrawn.

2. Rejection of Claims 18-23, 25, 27, 29, 30, 32, and 36 Under 35 U.S.C. § 103(a)

On page 4 of the Office Action, claims 18-23, 25, 27, 29, 30, 32, and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft et al. (U.S. Patent No. 6,463,278) in view of Katada (U.S. Patent No. 5,933,089). These rejections should be withdrawn because the cited references fail to teach or suggest at least one limitation in each of the rejected claims.

Claim 18 is in independent form and has been amended to recite "a plurality of light sensors configured to convert ambient light into signals to be received by the computing electronics." The Examiner acknowledged that Kraft et al. fails to teach or suggest this limitation. Katada likewise fails to teach or suggest this limitation. Katada discloses in Col. 6, lines 46-57, a light sensor 20 with photo sensors 21 and 22. Photo sensor 21 "receives the outdoor light received by a case 13." However, photo sensor 22 "receives the light from the back light module 60 as the light source," and does not receive/convert ambient light.

Atty. Dkt. No. 035451-0127 (3626.Palm)

Thus, only photo sensor 21 receives ambient light. Accordingly, Katada fails to teach or suggest using "a plurality of light sensors configured to convert ambient light into signals to be received by the computing electronics," as recited in independent claim 18. Applicants respectfully request that the rejection of independent claim 18, and corresponding dependent claims 19-28, be withdrawn.

Claim 29 is in independent form and has been amended to recite a combination of features including "computing electronics configured to operate a plurality of personal information management applications and other applications." Similarly, claim 36 is in independent form and has been amended to recite "computing electronics configured to operate a plurality of personal information management applications comprising a contacts application and a calendar application, and further configured to operate other applications."

With respect to claims 29 and 36, the Office Action relies on Kraft et al. in reciting:

the Office interprets the CPU (computing electronics) [of Kraft et al.] to handle such calendar or PIM data functions since Kraft et al. discloses the CPU to handle the phone modes (see column 6, lines 7-24). Further, the Office interprets the "contact" limitation of Applicant's claim to inherently be comprised with the phone device and user interface disclosed by Kraft et al. since such feature, having a list of saved dialed phone numbers is inherent to telephone devices.

Applicants submit that while Kraft et al. may disclose a CPU that permits a user to select a "mode" in which the phone will operate, and some phones may include a list of saved dialed phone numbers, this does not amount to a teaching or suggestion of the subject matter recited in Claims 29 and 36, as amended. Each of claims 29 and 36 recites "computing electronics" configured to operate "a plurality of personal information management applications" and "other applications." These features are characteristic of typical "smartphones" that enable a user to use a wide variety of applications, including those recited in claims 29 and 36 (e.g., personal information management applications, including contacts applications and calendar applications, other applications, etc.).

Atty. Dkt. No. 035451-0127 (3626.Palm)

It would not have been obvious to one of skill in the art at the time of the invention to include computing electronics configured to operate a plurality of personal information management applications and other applications in a device such as that disclosed in Kraft et al. First, devices such as the phone in Kraft et al. have restraints on the physical size and number of components. Adding computing electronics configured to operate the applications recited in claims 29 and 36 to the device in Kraft et al. would typically require additional input buttons, a larger keypad, etc., in addition to the light detector 16 already present. This may present problems with maintaining the "handheld" characteristic of the device as more components, etc. are required. Accordingly, one of ordinary skill in the art would not be motivated to further increase the physical size of the device of Kraft et al. by adding additional components to the already limited space available.

Second, providing a light source on a device having such applications as those recited in claims 29 and 36 increases the overall complexity of the device, which is already complex by nature of the different inputs received from users to operate the various applications. For example, a user of a device may be typing text into the device and inadvertently cover the light sensor or shadow the light sensor, resulting in the device dimming the display. This may confuse a user of the device. Thus, because of the resulting complexity and potential user confusion, one of ordinary skill in the art building a smartphone would not be motivated to turn to the teachings of Kraft et al. to add a light sensor,

Applicants submit that the Examiner is in effect relying on the teachings of the present application and hindsight reasoning to modify the teachings of Kraft et al. to arrive at the subject matter of the presently rejected claims, which is improper. Accordingly, Applicants respectfully request that the rejection of independent claims 29 and 36, and corresponding dependent claims 30-35 and 37, be withdrawn.

3. Rejection of Claims 28 and 31 Under 35 U.S.C. § 103(a)

On page 10 of the Office Action, claims 28 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft et al. in view of Katada, and further in view of Helms (U.S. Patent No. 5,952,992).

Atty. Dkt. No. 035451-0127 (3626.Palm)

Claims 28 and 31 depend from independent claims 18 and 29, respectively, which as discussed above, are believed to be patentable over Kraft et al. in view of Katada. Helms fails to make up for the deficiencies of Kraft et al. and Katada with respect to independent claims 18 and 29. Accordingly, independent claims 18 and 29, and corresponding dependent claims 28 and 31, are patentable over the combination of Kraft et al. in view of Katada, and further in view of Helms. Applicants respectfully request that the rejection of claims 28 and 31 be withdrawn.

4. Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Atty. Dkt. No. 035451-0127 (3626.Palm)

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 9/6/2007

By 

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 319-7306
Facsimile: (414) 297-4900

Matthew J. Swetlik
Attorney for Applicants
Registration No. 58,428